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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,464	10/17/2003	Ricardo J. Moro	MORO-1 CONT III	3062
7590	10/19/2005		EXAMINER	
Ansel M. Schwartz Attorney at Law Suite 304 201 N. Craig Street Pittsburgh, PA 15213			UNGAR, SUSAN NMN	
			ART UNIT	
			PAPER NUMBER	
			1642	
DATE MAILED: 10/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/688,464	Applicant(s) MORO, RICARDO J.	
	Examiner Susan Ungar	Art Unit 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The Election filed July 28, 2005 in response to the Office Action of March 29, 2005 is acknowledged and has been entered. Claims 25-39 have been canceled and claims 21-24 are pending and currently under prosecution.
2. Applicants election, without traverse, of Group I, Claims 21-24 is acknowledged.

Specification

3. The amendment to the specification filed July 28, 2005 is objected to because it inserts Table I at page 19, line 4 without deleting the Table I that is present at page 19 line 4, thus it appears that Applicant is repeating the information already at page 19. Further, the amendment is objected to because it is confusing, the amendment consists of two Table I's, one drawn to Organ and Tumor types and one drawn to Cancer+Patients. Appropriate correction is required.

Specification Objections

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Claims 21-24 are drawn to a method for treating cancer comprising introducing labeled antibodies against alphafetoprotein into a patient and reacting said antibodies against alphafetoprotein receptor. Given that the claims are originally filed, appropriate amendment of the specification to include the limitations recited in the claims, so as to have clear support or antecedent basis in the specification for these limitations, is required see MPEP 608.01(o).
5. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

6. Claims 21-24 are rejected under 35 USC 101 because they are drawn to a method for treating cancer cells in a patient comprising the steps of introducing an increased level of labeled antibodies against alphafetoprotein in relation to normal non-malignant individuals into the patient and reacting said labeled antibodies with alphafetoprotein receptor or alphafetoprotein receptor binding sites on said receptor. The invention appears to be inoperable because antibodies against one antigen, that is alphafetoprotein, will not bind either specifically or selectively to a different antigen, that is alphafetoprotein receptor.

Claim Rejections - 35 USC § 112

7. Claims 21-24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21-24 are indefinite because claim 21 recites the phrase “introducing an increased level of labeled antibodies against alphafetoprotein in relation to normal non-malignant individuals”. The claims are confusing because (a) the term “increased” is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention and (b) the claim appears to state that normal non-malignant individuals have a level of labeled antibodies in their systems since the claim requires that an increased level of labeled antibodies, in relation to normal non-malignant individuals, be administered.

8. No claims allowed.

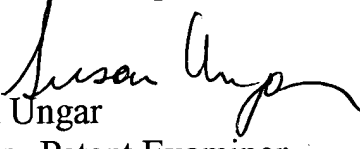
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is

(571) 272-0837. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at 571-272-0787. The fax phone number for this Art Unit is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Effective, February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1642.


Susan Ungar
Primary Patent Examiner
October 14, 2005